



1639

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Basiji et al. Attorney Docket No: BIOL0029  
Serial No: 09/976,238 Group Art Unit: 1639  
Filed: October 12, 2001 Examiner: Tran, My Chau T.  
Title: METHODS FOR SYNTHESIZING REPORTER LABELED BEADS

## ELECTION TRANSMITTAL LETTER

Bellevue, Washington 98004

December 5, 2002

**TO THE DIRECTOR OF THE PATENT AND TRADEMARK OFFICE:**

Transmitted herewith is an Election in Response to Restriction Requirement in the above-identified patent application. No additional claim fee is required, as shown below. Please charge any additional fees or credit any overpayment to Deposit Account No. 01-1940. A copy of this sheet is enclosed.

<u>Computation of Fee For Claims as Amended</u>					
	<u>Claims Remaining after Amendment</u>	<u>Highest Number Previously Paid For</u>	<u>Present Extra</u>	<u>Rate</u>	<u>Additional Fee</u>
Total Claims	40	40	-0-	x \$9	-0-
Independent Claims	10	10	-0-	x \$42	-0-
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT					<u>-0-</u>

Respectfully submitted,

Ron Anderson

Ronald M. Anderson  
Registration No. 28,829

I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid addressed to: Director of Patents and Trademarks, Arlington, VA 22202, on December 5, 2002.

Date: December 5, 2002

Kathy Parvin

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2 Applicants: Basiji et al. Attorney Docket No: BIOL0029  
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4 Filed: October 12, 2001 Examiner: Tran, My Chau T.  
5 Title: METHODS FOR SYNTHESIZING REPORTER LABELED BEADS  
6 ELECTION IN RESPONSE TO RESTRICTION REQUIREMENT

7 Bellevue, Washington 98004  
8 December 5, 2002

## 9 TO THE DIRECTOR OF THE PATENT AND TRADEMARK OFFICE:

10 The following is in response to a Restriction Requirement dated November 7, 2002, in which the  
11 Examiner issued a Restriction of the above-identified patent application. The Examiner asserts that the  
12 pending claims are directed to **eight** patentably distinct inventions. The Examiner indicates that a first  
13 invention (**Group I**) is directed to a method of constructing a library of reporter labeled beads, and is  
14 defined by Claims 1, 2 and 8-12, classified in Class 436, subclass 518. A second invention (**Group II**) is  
15 defined by Claims 3-7 and is directed to a method of constructing a library of reporters suitable for  
16 labeling beads, classified in Class 435, subclass 174. A third invention (**Group III**) is directed to a  
17 method of constructing an optically discriminable reporter and is defined by Claims 13-18, classified in  
18 Class 436, subclass 164. A fourth invention (**Group IV**) is defined by Claims 19-23 and is directed to a  
19 method of constructing a plurality of reporters, classified in Class 436, subclass 523. A fifth invention  
20 (**Group V**) is directed to a method of constructing a library of diverse compounds and is defined by  
21 Claims 24-33, classified in Class 435, subclass 4. A sixth invention (**Group VI**) is defined by  
22 Claims 34-36 and is directed to a method of constructing a library of diverse compounds using a step-  
23 wise synthesis, classified in Class 436, subclass 8. A seventh invention (**Group VII**) is directed to a  
24 method of constructing a library of different compounds using a step-wise synthesis and is defined by  
25 Claims 37-39, which are classified in Class 435, subclass 180. The eighth invention (**Group VIII**)  
26 identified by the Examiner is defined by Claim 40 and is directed to a method of constructing an optically  
27 discriminable reporter that is distinguishable by a specific imaging system with an aggregate reporter,  
28 classified in Class 436, subclass 169.

29 The Examiner further indicates that each of the eight inventions is classified in a different  
30 class/subclass, thereby requiring eight different searches, and that because such a search would be  
31 unduly burdensome, restriction is proper.

32 In response to the Restriction, applicant hereby elects the first invention indicated by the Examiner  
33 as Group I, including Claims 1, 2, and 8-12, with traverse.

34 Applicants respectfully submit that all claims in the present application are directed to subject  
35 matter best classified in Class 436, subclass 518, which is identified as "INVOLVING AN INSOLUBLE

1 CARRIER FOR IMMOBILIZING IMMUNOCHEMICALS," and is specifically directed to subject matter in  
2 which an immunological test is carried out using an antigen, antibody or fragment thereof as part of  
3 an artificially produced composition or complex or compound, which imparts the property of  
4 physical confinement or localization during a immunochemical analysis, and the processes for  
5 preparing the same. The carriers in the present instance are insoluble; reporters are immobilized on  
6 the carriers; and reporter labeled carriers are useful in immunological analysis. Although an exact  
7 match for the present invention does not appear to exist in the classification scheme employed by the  
8 U.S. Patent and Trademark Office, it appears that subclass 518 is the best classification for the  
9 subject matter recited in all of the pending claims.

10 The Examiner has classified Groups II, V, and VII in an entirely different class (i.e., in  
11 Class 435 instead of Class 436). Applicants respectfully disagree, and submit that *none* of the claims  
12 in the present invention relate to Class 435, which is specifically directed to:

- 13 A. A process of using a ***microorganism*** or ***enzyme*** to synthesize a chemical  
14 product.
- 15 B. A process of treating a material with a ***microorganism*** or ***enzyme*** to  
16 separate, liberate, or purify a preexisting substance.
- 17 C. An in vitro process of measuring and testing in which: (1) A  
18 ***microorganism*** or ***enzyme*** is used to determine the presence or identity of a  
19 compound or composition in a sample; (2) A ***microorganism*** is identified by  
20 propagation; (3) An ***enzyme*** is identified by its catalytic activity; (4) The  
21 presence of ***microorganisms*** is detected; (5) A live ***microorganism*** is used in  
an antigen antibody test as an antigen; (6) Fixed or stabilized nonliving  
***microorganisms***, cells, or tissues are involved.
- 22 D. A process of propagating a ***microorganisms***.
- 23 E. A process in which the genetic structure of a ***microorganisms*** or  
24 extrachromosomal genetic structure is altered.
- 25 F. A process of ***organ*** or ***tissue maintenance***.
- 26 G. A process of ***mashing*** or ***malting***.
- 27 H. Apparatus claimed or solely disclosed as useful for A-G.
- 28 I. ***Microorganisms***, per se, or the subcellular parts thereof.
- 29 J. ***Enzymes***, immobilized enzymes or enzyme containing compositions not  
30 otherwise provided for and the processes for purifying enzymes or forming  
31 immobilized enzymes.
- 32 K. Compositions claimed or solely disclosed as for the propagation of  
33 ***microorganisms*** or for measuring and testing processes in C above.
- 34 L. Using ***microorganisms*** to destroy hazardous or toxic waste.

1       The claims associated with Groups II, V, and VII (as defined by the Examiner in the restriction)  
2 do not recite *enzymes* or *microorganisms*, or involve *mashing/malting* or *tissue/organ maintenance*. It  
3 appears that based on the U.S. PTO definitions of Class 435 and Class 436, the claims associated with  
4 Groups II, V, and VII more closely correspond to Class 436 than Class 435. The Examiner has not  
5 provided any justification for a conclusion that any of the claims defined in the present application relate  
6 to enzymes, microorganisms, malting/mashing, or tissue/organ maintenance (i.e., to Class 435).

7       Both Group I and Group III deal with optically discriminable reporters, and thus logically, both  
8 groups should be classified in the same class/subclass. Subclass 164 (in which the Examiner indicates  
9 Group III should be searched) specifically deals with subject matter *wherein the basis for analysis is an*  
10 *optical result of a chemical reaction that is measured mechanically or visually*. However, the claims  
11 associated with Groups I and III are directed to methods for producing reporters and libraries, and not to a  
12 method for mechanically or visually measuring an optical result of a chemical reaction, even though it is  
13 true that the reporters in applicants' invention can be optically distinguished. Neither of Groups I or III  
14 are properly classified in subclass 164. The claims assigned to Groups I, II, and IV-VIII all include at  
15 least one optically distinguishable element (reporters or carriers), and the claims in Groups IV and VIII  
16 specifically recite an imaging system. It is thus not clear why if Group III is searched in subclass 164,  
17 subclass 164 should not also be searched for prior art relating to the other groups reciting optically  
18 distinguishable elements and imaging systems. Because Group III is directed to a method for producing  
19 an optically discriminable element, and the claims defined by other groups similarly relate to optically  
20 distinguishable elements, it appears that the subject matter of the claims in Groups I-III, V, and VII are  
21 more properly classified in Class 436, subclass 518, and therefore should be examined together.

22      The Examiner has indicated that the subject matter of the claims in Group 4 is classified in  
23 Class 436, subclass 523. Applicants note that subclass 523 is closely related to subclass 518, and  
24 deals with *subject matter wherein the carrier is particulate and the particles are formed or chosen to*  
25 *be different sizes or are coated with chemically different coatings*. Applicants note that the subject  
26 matter of the claims in Group IV relates to using reporters that are too small to be individually  
27 discriminable using an imaging system, to generate a library of discriminable reporters that comprise  
28 aggregates of the smaller reporters. The aggregate reporters thus produced are clearly optically  
29 discriminable. These aggregates are not necessarily of different size, but can be identical in size and  
30 different in composition. It appears that the subject matter of the claims in Group IV is similar  
31 enough to that of the claims in Groups I-III, V, and VII, so that the search for related prior art should  
32 be made in the same Class and subclass.

33      The Examiner has indicated that the claims in Group VI should be search in Class 436,  
34 subclass 8. Applicants note that subclass 8 is directed to *compositions, which are used to mimic or*  
35 *quantify the effect, in a chemical test procedure, of another chemical composition, or to stabilize,*

1 preserve or otherwise prepare a sample for a chemical test and the processes of use of such materials  
2 preparatory to a chemical test procedure. However, the subject matter of Group VI is directed to a  
3 library of compounds that each include optically distinct carriers, and that library is not related to the  
4 uses described for inventions classified under subclass 8. Further, the subject matter of Groups I, II,  
5 and V is directed to libraries, and it is not clear why such similar inventions should be classified  
6 differently. It appears that the subject matter of claims in Group VI is so closely related to that of the  
7 claims in Groups I-V and VII that all the subject matter of all these groups should be in the same  
8 Class and subclass and examined together.

9 Finally, the Examiner has indicated that the subject matter of Group VIII is classified in  
10 Class 436, subclass 169. Subclass 169 is applicable to inventions wherein the material to be analyzed  
11 is reacted with a reagent contained in absorbent or bibulous carrier or substrate. The classification  
12 manual specifically mentions *test strips, wicks, and dip-sticks* as examples of this class/subclass. The  
13 claims in Group VIII relate to constructing optically discriminable reporters, which are unrelated to  
14 test strips, wicks, and dip-sticks. However, optically discriminable reporters are so related to the  
15 subject matter of Groups I-VII, that logically, all the claims in all of these groups should be classified  
16 and examined together. If properly classified, it will be apparent that substantially the same effort  
17 will be required to search for related prior art for all of the claims in this case. Accordingly,  
18 applicants request that the Examiner withdraw the Restriction.

19  
20 Respectfully submitted,

21  
22   
23

24 Ronald M. Anderson  
25 Registration No. 28,829

26 I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed  
envelope as first class mail with postage thereon fully prepaid addressed to: Director of Patents and  
27 Trademarks, Arlington, VA 22202, on December 5, 2002.  
28

29 Date: December 5, 2002  
RMA/MCK:

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